

REMARKS

Claims 1-35 are currently pending in the application. Claims 1-2, 10-13, 17, 20-21, 28-23 and 34 are amended. The amendments find support in the specification. For instance, the employee's being able to create a profile of work activities by selecting from a directory of work activities is supported at page 2, lines 8-10; page 11, lines 13-30; page 14, lines 3-12; page 14, line 24 to page 15, line 2; and page 15, line 25 to page 16, line 2. Classifying each work activity in the directory by work activity group is supported at page 6, lines 26-29; page 11, lines 8-30; and page 14, lines 3-12. Further defining the work activities by organizational level within each work activity group is supported by the specification at page 7, lines 1-3; page 11, lines 13-30; page 14, lines 3-12; page 14, line 24 to page 15, line 8; and page 15, line 25 to page 16, line 15. Correlating the work activities of the employee into work activity groups is supported by the specification at page 6, lines 26-29; page 11, lines 8-30; and page 14, lines 3-12. Correlating other factors is also supported by the specification, including the organizational level of the work activities performed within each work activity group (page 7, lines 1-3; page 11, lines 13-30; page 14, lines 3-12; page 14, line 24 to page 15, line 8; and page 15, line 25 to page 16, line 15), the number of work activities performed at each organizational level within each work activity group (page 14, line 24 to page 15, line 8; page 16, lines 3-15), the percentages of time allocated to the aggregate work activities within each work activity group (page 12, lines 1-11; page 13, lines 9-15; page 15, lines 14-20; page 16, line 29 to page 17, line 2), and external market rates of the work activities within each work activity group (page 8, lines 17-21; page 14, lines 16-21; page 15, lines 9-13 and 20-24; page 16, lines 15-17; page 16, line 29 to page 17, line 2). No new matter is added.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-2, 10-13, 17, 20 and 28-30 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite on the grounds that the term "market valuation" is not mentioned in the disclosure, although the term "market value" is.

Applicant notes that there is no requirement that the subject matter of the claims be described literally, *i.e.*, using the same terms or *in haec verba*. M.P.E.P. § 2163.02. Nevertheless, Applicant has amended claims 1-2, 10-13, 17, 20 and 28-31 as suggested by the

Examiner. Applicant respectfully requests that the rejection on this basis be reconsidered and withdrawn.

Claim Rejection Under 35 U.S.C. § 103

Claims 1-9, 11-16, 18-19, 21-35 were rejected under 35 U.S.C. § 103 as being unpatentable over Skinner *et al.* (U.S. Pat. No. 5,063, 914) and Sanders (U.S. Pat. No. 6,411, 936).

However, the Office Action fails to establish a *prima facie* case of obviousness because the cited references fail to teach or suggest all of the claim limitations, and because there is no motivation to combine the references. The combination of Skinner *et al.* and Sanders also fail to provide an enabling disclosure, as required by 35 U.S.C. § 103.

The Requirements For an Obviousness Rejection

As explained in the Manual of Patent Examining Procedure § 2142, to establish a *prima facie* case of obviousness under the requirements of 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (*In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Second, there must be a reasonable expectation of success. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest *all the claim limitations*. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, "References relied upon to support a rejection under 35 USC 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public." *In re Payne, Durden, and Weiden*, 203 U.S.P.Q. 245, 255 (C.C.P.A. 1979) (citing *In re Brown*, 51 C.C.P.A. 1254, 1259, 329 F.2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964)).

The References Fail To Teach All of the Claim Limitations

The Examiner argues that Skinner *et al.* teaches a system, a method and an apparatus which provides “a server for providing a site through which each of the plurality of employees creates a profile of the work activities of the employee” (citing column 20, lines 35-45) and a computer capable of accessing the site over a network, “each of the plurality of employees using the computer to create the profile of the work activities of the employee, and transmit the information about the work activities of the employee to the server” (citing column 2, lines 43-54 and column 2, line 67 to column 3, line 3).

Column 20, lines 35-45 of Skinner *et al.* says nothing about employee work profiles, but only states that the system can use a variety of operating systems and a web browser. There is no mention of an employee creating a profile of his work activities. Likewise, column 2, lines 43-54 and column 2, line 67 to column 3, line 3 clearly and unequivocally state that Skinner *et al.* discloses

a time tracking system . . . to produce automatic documentation and unalterable proof of work done on a computer. This will allow managers to feel more comfortable with having their computer-oriented employees telecommute Self-employed professionals who use a computer to generate income can use this product to document their work and automatically generate invoices that accurately documents [sic] the time and work done by the computer professional. . . .

. . . . Anyone working with a personal computer can have an automatic, accurate, and reliable means of documenting time and work done with a personal computer.

(emphases added). It is therefore clear from the passages cited in the Office Action that Skinner *et al.* fails to disclose either a system, a method or an apparatus for creating a profile of the work activities of an employee, and then calculating a market value for the profile (independent claims 1, 11, 12, 28 and 30) or analyzing the work activity profile (independent claims 21, 32 and 34). The system of Skinner *et al.* tracks time that an employee has actually worked on a computer. This reference fails to teach the limitations of Applicant’s claims, for instance, that a profile is created of an employee’s work activities.

The Examiner states that Skinner *et al.* does not teach market valuation, and relies on Sanders to supply this teaching. The Examiner argues that Sanders teaches “calculating a market

valuation for the profile of the work activities of the employee” (citing column 16, lines 14-18; column 19, lines 10-14 (claim 11 of Sanders)) by “correlating the work activities of the employees, percentages of time allocated to the work activities of the employees, and salary rates” (citing column 20, lines 31-39 (claim 22 of Sanders)).

However, the cited passages of Sanders state only that the system for calculating the value of a company can also be used to track “a potential for movement in the . . . market valuation per employee of the enterprise” (column 16, lines 14-18), or that the system can include “market valuation per employee growth” (column 19, lines 10-14), or that the method for determining the most appropriate actions of a company can include “information about human resources” (column 20, lines 29-30), and that the information about human resources can include at least one of the following: “employee functions, relevant experience, training, knowledge and personality attributes, skills, capabilities, and contact information regarding the various individuals in the enterprise together with their current responsibilities, their position in the organizational structure, their current knowledge activity, current capability utilization, salaries, wages, benefits, and bonuses” (column 20, lines 32-39). Sanders does not state that the system calculates or otherwise determines the market value of an employee, nor does it teach or suggest anything about how such market valuation is achieved. It states that the market values of employees can be used, but does not provide a method for obtaining them. This is in contrast to Applicant’s claims, which specifically set forth how the value of an employee is measured. There is no teaching or suggestion in Sanders of creating a profile of the work activities of the employee.

Where none of the references relate to or disclose the creation of a profile of an employee’s work activities, their combination, even if proper (which is not conceded), cannot be considered to do so. The rejection on the basis of these two references should be reconsidered and withdrawn.

There Is No Motivation to Combine the References

The rejection also fails the first requirement for a *prima facie* case of obviousness -- there is no motivation to combine these references.

The Examiner asserts that “[i]t would have been obvious to a person of ordinary skill to employ the teachings of Sanders” (citing column 4, lines 10-21 of Sanders) “with the system of Skinner” (citing column 19, lines 17-23 of Skinner). However, as stated above, Sanders teaches that the market value of an employee can be used in calculating overall value of a company, but does not state how to obtain the value. The system of Skinner *et al.* is a time-billing system for calculating the paycheck of an employee for hours worked.

The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *Berghauser v. Dann*, *Comr. Pats.*, 204 U.S.P.Q. 393 (Dist. DC 1979); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Citing references which merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. *Ex parte Hyamizu*, 10 U.S.P.Q.2d 1393 (Bd. Pat. App. & Inter. 1988).

The Federal Circuit has stated that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching[,], suggestion or incentive supporting the combination” (*In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)) and that “[i]t is impermissible . . . simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant’s combination would have been obvious.” (*In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991)).

Skinner *et al.* is directed to a time billing system for computer workers. Sanders is directed to a system for calculating the value of a company. One of ordinary skill, reading these two references, simply would not combine them. Instead, the Examiner has used Applicant’s claims as the source of the motivation to combine the references. The Examiner does not explain how the references teach the claim limitations. The Examiner uses Applicant’s claims as a template for selecting disparate elements from the references. Thus, impermissible hindsight has been to reconstruct Applicant’s claims. The rejection should be reconsidered and withdrawn.

Claims 10, 17 and 20 were also rejected under 35 U.S.C. §103 as being unpatentable over Skinner *et al.*, Sanders and Paizis (U.S. Pat. No. 6,338,042).

As discussed above, Skinner *et al.* and Sanders fail to establish a *prima facie* case of obviousness against Applicant's claims. Among other deficiencies, the two references fail to teach or suggest all of the limitations of Applicant's claims.

The addition of Paizis' fails to cure this deficiency. Paizis discloses methods and apparatus for incorporating measures of competency and contribution into pay decisions. The Examiner asserts that Paizis teaches that work activities group values are weighted, and cites column 5, lines 43-47. However, this passage states that competency and "contribution score weightings" can be provided to the payment computer program. It neither teaches nor suggests that a profile should be created of the work activities of an employee.

Nothing in Skinner *et al.*, Sanders or Paizis renders Applicant's claims obvious. The rejection on the basis of these references should be reconsidered and withdrawn.

Applicant submits that all of the claims are now in condition for allowance, which action is requested. Please apply any charges or credits to Deposit Account No. 50-1721.

Respectfully submitted,



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Date:

April 14, 2005